

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-20 and 32-39² 35 U.S.C. § 101, and rejected claims 1-47 under 35 U.S.C. § 103(a) as being unpatentable over *Hauser et al.*, U.S. Patent No. 6,536,569 ("*Hauser*").

By this amendment, Applicants amend claims 1-6, 9-32, 40, and 41, and cancel claims 7, 8, and 37-39, without prejudice or disclaimer. Claims 1-6, 9-36, and 40-47 are currently pending in the application.

I. Rejection of Claims 1-20 and 32-39 under 35 U.S.C. § 101

Applicants respectfully traverse the Office Action's rejection of claims 1-20 and 32-39 under 35 U.S.C. § 101. The Office Action alleges that the claims are drawn to non-statutory subject matter. Office Action, p. 2-3. Applicants respectfully traverse.

Although Applicants do not acquiesce to the Section 101 rejection of claims 1-20, Applicants amend claim 1 to recite "[a] computer-implemented method . . . comprising the steps, performed by a computer, of . . . issuing, from a first computer-implemented management system" (emphasis added). Similar amendments have been made to independent claims 9, 13, and 20. Applicants submit that claims 1, 9, 13, and 20, as amended, are sufficiently tied to a machine, for example the claimed "computer," and "database," to satisfy the machine-or-transformation test set forth in *In re Bilski*, 545

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² The Office Action lists claims 1-20 as rejected under Section 101. Office Action, p. 2. The Office Action also states claim 32 is rejected under Section 101. Office Action, p. 3. For purposes of this response, Applicants assume the Examiner also intended to reject independent claim 32 and claims 33-39, depending from claim 32, under Section 101.

F.3d 943, USPQ2d 1385 (Fed. Cir. 2008) (*en banc*). Accordingly, Applicants request the reconsideration and withdrawal of the Section 101 rejection of amended independent claims 1, 9, and 13, and claims 2-6, 10-12, and 14-20, which depend from claims 1, 9, and 13. Claims 7 and 8 are cancelled, rendering the rejection of these claim moot.

Independent claim 32, as amended, recites a system including, for example, “a first computer . . . [and] a second computer” Claim 32 therefore positively recites hardware elements, comprising a system that falls under the category of “machine” and meets the requirements of 35 U.S.C. § 101. Claims 33-39 which depend from claim 32, meet the requirements of 35 U.S.C. § 101 at least due to their dependence.

II. Rejection of Claims 1-47 Under 35 U.S.C. §103(a)

Applicants respectfully traverse the Examiner’s rejection of claims 1-47 under 35 U.S.C. § 103(a) as being unpatentable over *Hauser*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.”

M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

M.P.E.P. § 2143.03. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 defines a computer-implemented method for managing a return of a product, including, "receiving a return request for the product, wherein the return request is for a quantity of the product greater than one . . . [and] **splitting the record** in the second management system **into a plurality of new records** with the [return authorization number] **when less than all of the quantity is received,**" emphasis added. *Hauser* fails to teach, suggest, or make obvious at least these elements as recited in amended claim 1.

In a discussion of claim 7, now cancelled, the Office Action alleges *Hauser* teaches “splitting the record in the second management system into a plurality of new records with the RAN when less than all of the quantity is received” by referencing Figure 1 and column 4, lines 2-35 of *Hauser*. Office Action, p. 8. This characterization of *Hauser* is incorrect.

The referenced portion of *Hauser* describes a process for “providing [an] appropriate printable bar-coded return authorization shipping label.” *Hauser*, col. 4, lines 2-35. Neither this, nor any other portion of *Hauser* includes a teaching or suggestion of “splitting [a] record . . . when less than all of [a] quantity is received.” Therefore, *Hauser* does not teach, suggest, or make obvious “receiving a return request for the product, wherein the return request is for a quantity of the product greater than one . . . [and] **splitting the record in the second management system into a plurality of new records with the [return authorization number] when less than all of the quantity is received,**” as recited in amended claim 1 (emphasis added).

In addition, Applicants note that *Hauser* is the only reference relied upon by the Examiner for this particular rejection. The M.P.E.P. sets forth that

[t]he distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. M.P.E.P. § 706.02(IV).

The M.P.E.P. clearly instructs that, for a proper 35 U.S.C. § 103 rejection, "the reference teachings must somehow be modified in order to meet the claims." *Id.* Therefore, if the Office Action applies a 35 U.S.C. § 103(a) rejection based on *Hauser*, the Office Action must articulate how *Hauser* must be modified to supposedly teach each and every claim element. The Office Action does not explain how or why *Hauser* must be modified, other than to make a generalized allegations that "the insertion of the term 'management' in the system above would have been obvious to indicate 'monitoring' effects if desired" and "it would have been obvious to use the features 'providing or sending the return authorization code' and sending the message back to the merchant indicated a complete return of the merchandise occurred so that the merchant can be able to keep track the status of which merchandised has been returned at the facility or warehouse." Office Action, p. 14.

Moreover, "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." M.P.E.P. § 706.02(j). The Office Action's rejections, however, do not explain why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification to meet the elements of Applicants' independent claims. The M.P.E.P. further instructs that,

[a]fter indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) *an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.* Id., italics added.

In this rejection, the Office Action has not set forth “an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.” Id. Accordingly, the rejection is improper for at least this additional reason.

In view of the above, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41, although of different scope from claim 1 and each other, recite elements similar to those in claim 1 and are also allowable for at least the reasons stated above. Claims 2-6, 10-12, 14-19, 22, 23, 25-30, 33-36, and 42-47 are also allowable at least due to their dependence from the independent claims. Claims 7, 8, and 37-39 are cancelled, rendering their rejection moot.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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